

- H2
end
- 20 least in part on the contents of a table entry corresponding to the address range in which the
21 instruction of the process lies.

REMARKS

This paper supplements the Request for Reconsideration filed on July 8, 2002, in response to the Office Action of March 7, 2002.

I. Comments on Examiner's Interview Summary

The Examiner's Interview Summary was received after the paper of July 8, 2002 was filed. It appears that the Interview Summary generally reflects the Examiner's position at the beginning of the interview, and does not reflect several agreements that were reached on underlying issues. The Examiner's Interview Summary also reflects some misunderstanding of the views advanced by Applicant during the Interview.

A. Paragraph 1: "the law and the rules"

This paragraph misstates the subject matter of the interview. The issues were not to identify the law with "which Applicants are required to comply." Rather, as clearly shown in the correspondence between Applicant and Examiner, Applicant's questions centered on whether the Office Action of March 2002 complied with legal requirements binding on examiners.

During the Interview, Applicant and Examiner reviewed several provisions of Chapter 2100 of the MPEP, and reached agreement that these provisions had not been observed in the previous Office Actions. For example, it was agreed that the Office Action of March 2002 makes no mention of "undue experimentation." It was agreed that the Office Action of March 2002 makes no comparison of several claim elements to the prior art. It goes without saying that where a provision of Chapter 2100 has not been complied with, there is no rejection under the related statutory section. No § 112 ¶ 1 enablement rejection can possibly exist without a showing of "undue experimentation." No § 102 or § 103(a) rejection can possibly exist without comparison of every element of the claims to the prior art.

B. Paragraph 2: "The invention"

The Examiner's Interview Summary states that "Applicants said that the invention is..." Applicant believes that this is an incorrect paraphrase of the conversation. The only legally-

relevant characterization of the "invention" is the claims, and Applicant believes there was no deviation by Applicant from that well-established principle. The independent claims, at least, do not mention "separate hardware," "Intel X86," or "RISC Instruction Set."

Paragraph 2 also omits an important point raised during the interview -- if the nails are thrown away but the box-builder substitutes an alternative way of attaching the four pieces of wood, or uses the wood to build something other than a box, then the method has utility.

C. Paragraph 3: "Likelihood"

The Examiner is reminded that there is no requirement that a claim recite all components of an operable device. The Federal Circuit has rejected such reasoning. *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1180-81, 20 USPQ2d 1094, 1100 (Fed. Cir. 1991) reads as follows (emphasis added, citations and quotations omitted):

To meet the utility requirement, the Supreme Court has held that a new product or process must be shown to be "operable"—that is, it must be "capable of being used to effect the object proposed." Our cases have not, however, interpreted this language in *Mitchell* to mean that a patented device must accomplish all objectives stated in the specification. On the contrary, "when a properly claimed invention meets at least one stated objective, utility under § 101 is clearly shown." The utility requirement, though an essential requisite of patentability, has other limits. An invention need not be the best or the only way to accomplish a certain result, and it need only be useful to some extent and in certain applications. "[T]he fact that an invention has only limited utility and is only operable in certain applications is not grounds for finding lack of utility."

The district court misapplied the claim definiteness requirement in holding claim 3 to be invalid for failure to claim the subject matter regarded as the invention. Focusing on the fact that claim 3 omits any electrical circuitry or other signalling means, the court concluded that the claim "does not describe McMurtry's invention." ... Stating that "the arbitrary presentation of part of an invention does not constitute a claim of a valid invention," the court essentially ruled that McMurtry cannot claim a part of his invention separate from the rest. This reasoning is legal error.

It has long been held, and we today reaffirm, that it is entirely consistent with the claim definiteness requirement of the second paragraph of section 112, to present "subcombination" claims, drawn to only one aspect or combination of elements of an invention that has utility separate and apart from other aspects of the invention. As one of our predecessor courts stated, "it is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter," as it is "entirely appropriate, and consistent with § 112."

H

to present claims to only [one] aspect." Thus, the holding of invalidity that rests on a conclusion of lack of claim definiteness is legally incorrect.⁵

⁵ Such subcombination claiming is also consistent with the utility requirement of section 101, so long as what is described in the claim has utility in itself.

Applicant's attorney has spoken with both Steve Kunin and Magdalen Greenlief, and both have confirmed that the Examiner is obligated to follow Federal Circuit precedent, such as *Zeiss*, quoted above. Applicant is unaware of any statute, regulation, provision of the MPEP, or case that authorizes an examiner to reject a claim merely because the examiner believes that the claim does not recite all elements required for practical use of a device. If the Examiner knows of any authority that authorizes such a rejection, he is requested to provide a citation or a copy.¹

Without such a citation, Applicant respectfully requests that no such rejection be raised.

D. Paragraph 4: adding further claim limitations

The two issues raised in paragraph 4 of the Interview Summary are addressed in Applicant's paper filed July 8, 2002, at section IX.C.14 at pages 37-40, and in section V.D, at pages 6-7. On the prior art of record today, there appears to be no legal provision that would require the amendments mentioned in the Interview.

II. Proposal to ensure forward progress of prosecution

If no rejection or objection can be raised, that includes all showings required by the MPEP, Applicant requests a Notice of Allowance.

If, after reconsideration, the only outstanding requirement relates to rejections under § 102 or § 103(a), over a new reference, an Office Action that effectively advances prosecution – by considering every limitation of every claim – would be appreciated.

If the Examiner believes that any other rejection or requirement should be raised, old or new, under any statute, rule, case, or MPEP provision, Applicant requests an interview to clarify any issues or misunderstandings first.

¹ *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759-60 (Fed. Cir. 1995), overturned an analogous rejection for indefiniteness. No rejection under § 112 ¶ 2 is warranted.

H

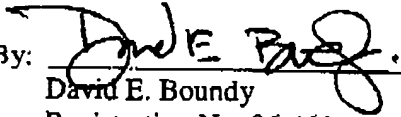
In view of the amendments and remarks, Applicant respectfully submits that no claim is rejected by the Office Action of March 2002. Further, the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any further extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account 50-0675, Order No. 5231.16-4004C.

Respectfully submitted,

SCHULTE ROTH & ZABEL

Dated: August 27, 2002

By:


David E. Boundy
Registration No. 36,461

Mailing Address:
SCHULTE ROTH & ZABEL
919 Third Avenue
New York, New York 10022
(212) 756-2000
(212) 593-5955 Telecopier

H